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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/804,825	03/13/2001	Kimihito Yamasaki	55698(904)	2050

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EXAMINER

SWEARINGEN, JEFFREY R

ART UNIT	PAPER NUMBER
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2145

DATE MAILED: 06/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/804,825

Applicant(s)

YAMASAKI ET AL.

Examiner

Jeffrey R. Swearingen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,4-10 and 33-35 is/are pending in the application.
- 4a) Of the above claim(s) 2-3 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,4-10 and 33-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 3/27/2006 have been fully considered but they are not persuasive.
2. The rejection of claim 4 under 35 U.S.C. 112, second paragraph is maintained. One of ordinary skill in the art would be unclear what is meant by something that is "indicative of a state of use of said management target device...". Suggested wording to fix this problem is "indicating said management target device's state of use".
3. The rejection of claim 34 under 35 U.S.C. 112, second paragraph is maintained. A higher compression rate than the compression of mail data failed to provide any type of standard for the compression rate, and is an indefinite and relative term. Since no compression is present in claim 2, Applicant is suggested to rewrite the claim to "wherein said attached data is compressed."
4. Applicant argued Motoyama failed to disclose transmitting information from the device to a managing device. The managing device in Motoyama was the device where the administrator received the message. The information collecting device was the Resource Administration Station referred to in page 16 of Applicant's remarks. The teaching of Motoyama is not opposite that of the claimed invention.
5. Applicant argued there was no separation of mail data and attached data in Motoyama. For starting information, Applicant is reminded that HTML was a common "mail data" format at the time of the invention. Applicant stated "...mail data are data in a standard format (for instance, text format) set according to the electric mail system, and easily viewed by mail-dedicated software (mailer)...the attached data are data in a format different from the standard format of electric mail systems, and are not viewed by means of generally-used mailers. In other words, attached data are made visible by means of software different from mailers, which are data less possibly perceived by the third party." Specification, page 7. HTML was a standard text format at the time of the invention. Excel was data made visible by means of software different from mailers. Motoyama stated the report "may be customized" by "providing predetermined requested information" and/or by the use of a "predetermined format, such as, for example, Excel format or HTML format for ease of viewing". The and/or showed Motoyama taught that both predetermined requested information was in the email and that information was presented in

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addition to the predetermined requested information in a predetermined format. The presence of the two formats necessarily taught the separation of the data into two sections – a "mail data" and an "attached data".

Claim Objections

6. Claims 4 and 34 are objected to because of the following informalities: Claims 4 and 34 are dependent upon claim 2, which has been canceled. Appropriate correction is required. Claims 4 and 34 are treated as being dependent upon claim 1.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 4 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Claim 4 refers to "indicative of a state of use". The language is confusing, and one of ordinary skill in the art would be unclear what Applicant intends by the phrase "indicative of a state of use".

10. The term "higher" in claim 34 is a relative term which renders the claim indefinite. The term "higher" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. No metes and bounds exist to allow one of ordinary skill in the art to adequately gauge what is meant by the "higher" compression rate and how that compression rate is being compared to an assumed "lower" compression rate.

Claim Rejections - 35 USC § 102

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11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1-10 and 33 are rejected under 35 U.S.C. 102(e) as being anticipated by Motoyama et al. (U.S. Patent No. 6,631,247).

13. In regard to claim 1, Motoyama disclosed *an information selecting section for selecting which of the collected device information is to be converted into mail data and which of the collected device information is to be converted into attached data; and a transmission processing section that converts the collected device information into attached data or mail data, in accordance with the selection performed by the information selecting section, and transmits an electric mail containing both the attached data and the mail data to said managing device*. Motoyama disclosed sending status messages from a device to a server by use of electronic mail. See Motoyama, column 14, lines 1-53. Motoyama disclosed that data was in a predetermined format such as Excel or HTML. Column 14, lines 16-20. Attachments were used in the electronic mail messages. Column 17, lines 58-63. Motoyama disclosed the usage of a command to collect device information *from the external* in column 18, lines 1-62. Attachments were used in email as shown in column 17, lines 58-63, and further as inherently shown in column 14, lines 16-20.

14. In regard to claim 4, Motoyama is applied as in claim 2. Motoyama further disclosed *said transmission processing section is set so as to convert use information indicative of a state of use of said management target device into attached data*. See column 14, lines 1-62, where data regarding the status of a device was sent via email to a managing device. The use of the Excel format in lines 16-20 taught the use of attachments, as also shown in column 17, lines 58-63.

15. In regard to claim 5, Motoyama is applied as in claim 1. Motoyama further disclosed *said transmission processing section is set so as to transmit device information regarding a plurality of*

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management target devices located in a predetermined area by a same electric mail. See column 14, lines 21-40, where multiple devices can transmit status information to a managing server.

16. In regard to claim 6, Motoyama is applied as in claim 1. Motoyama further disclosed *said transmission processing section is set so as to send the electric mail transmitted to the manager, also to another destination according to a request by a user.* Motoyama disclosed that multiple persons such as home users were recipients of the status information messages. Column 14, lines 54-62.

17. In regard to claim 7, Motoyama is applied as in claim 1. Motoyama further disclosed *said transmission processing section includes an encoding section for encoding attached data, and is set so as to have the encoded attached data in an electric mail.* In column 14, Motoyama disclosed the encoding of data into a format such as Excel or HTML. In column 17, lines 58-63, Motoyama disclosed sending email with attachments present. The relationship of these attachments to the Excel or HTML formats being sent to a user in column 14 is inherent to Motoyama.

18. In regard to claim 8, Motoyama disclosed *an information communication device notifying a managing device of device information collected regarding a management target device by electric mail, said information communication device including an information selecting station for selecting which of the collected device information is to be converted into attached data; and a transmission processing section that converts the device information into attached data or mail data, in accordance with the selection performed by the information selecting section, and transmits an electric mail containing both the attached data and the mail data to said managing device; a management target device that causes said information communication device to transmit an electric mail containing device information; and a managing device that performs remote management of said management target device, based on the device information contained in the electric mail transmitted from said information communication device.* Motoyama disclosed the transmission of status information for a device using email and attachments in column 14, lines 1-53, and column 17, lines 58-63. Motoyama disclosed managing the device remotely via email commands in column 18, lines 39-62. The remaining limitations of claim 8 are treated in the rejection of claim 1.

19. Claim 9 is substantially the same as claim 1.

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20. Claim 10 is substantially the same as claim 1.

21. In regard to claim 33, Motoyama is applied as in claim 1. Motoyama further disclosed *said attached data is produced by a dedicated program, whereby said attached data is readable only by said dedicated program*. Motoyama allowed a user to transmit data in a predetermined format. Column 14, lines 16-20. The transmission of data in a predetermined format such as Excel was readable only by a "dedicated program" such as Excel.

Claim Rejections - 35 USC § 103

22. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

23. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Wong et al. (U.S. Patent No. 6,654,746).

24. In regard to claim 34, Motoyama is applied as in claim 1. Motoyama failed to disclose the compression of an email attachment. However, Wong in the field of art of email transmission disclosed the ability to transmit a compressed email attachment within a message in column 10, lines 13-27. Therefore it would have been obvious to one of ordinary skill in the art to compress the attachments in Motoyama as shown by example in Wong in order to reduce internet traffic, bandwidth usage, and packet transfer latency during transmission.

25. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Motoyama in view of Official Notice.

26. In regard to claim 35, Motoyama is applied as in claim 1. Motoyama failed to disclose filtering of "confidential" data from data and attaching it separate from other data in an email message. However, privacy filters and mail filters were well known to one of ordinary skill in the art, and were commonly used in defense and national security applications to prevent information from being sent in the open. Further,

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at the time of the invention public key cryptography was commonly used in email and involved transmitting a private key along with mail data to allow a user to decrypt the message. Seeing that many privacy applications were in existence at the time of the invention to allow for sending confidential data in the private along with mail data in the public, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate such technology into an email management program to prevent proprietary device information and password information from being intercepted by cyber criminals during the transmission of said email messages.

Conclusion

27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

28. Halevi, Shai et al. "Public-Key Cryptography and Password Protocols". ACM Transactions on Information and System Security. Vol. 2, No. 3, August 1999, pp. 230-68.

29. Bhushan, Bharat et al. "Requirements and the Concept of Cooperative System Management." International Journal of Network Management. Volume 8, 139-58. 1998.

30. Winters, Gerald et al. "An Architecture for Monitoring and Modeling Network Systems." Proceedings of the 1995 conference of the Centre for Advanced Studies on Collaborative research. IBM, 1995.

31. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

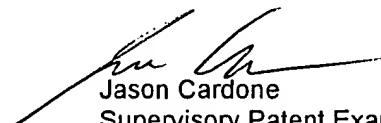
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey R. Swearingen whose telephone number is (571) 272-3921. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jason Cardone can be reached on 571-272-3933. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jason Cardone
Supervisory Patent Examiner
Art Unit 2145